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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,996	11/14/2001	Erwin Bauer	GR99P8059	5736
7590 02/18/2004			EXAMINER	
LERNER AND GREENBERG, P.A. Post Office Box 2480 Hollywood, FL 33022-2480			AGUIRRECHEA, JAYDI A	
			ART UNIT	PAPER NUMBER
			2834	
DATE MAILED: 02/18/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,996

Applicant(s)

BAUER ET AL.

Examiner

Jaydi A. Aguirrechea

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballmann et al. (US 5887553) in view of Voros. (US 3670188).

Ballmann et al. disclose an electromagnetic actuator, comprising: at least one electromagnet (1) having a coil and a first contact surface; a second contact surface; at least one resetting device (3), an armature (6) having a shank (5) mechanically coupled to the resetting device (3), the armature (6) being movable between the first contact surface on the electromagnet (1) and the second contact surface. Ballmann et al. disclose an electromagnetic actuator assembly, comprising: at least one electromagnet (1) having a coil and a first contact surface; a second contact surface; at least one resetting device (3); an armature (6) having a shank (5) mechanically coupled to the resetting device (3), the armature (6) being movable between the first contact surface on the electromagnet (1) and the second contact surface; a support (between 3 and 2) mounting the electromagnet (1) and the armature (6).

However, Ballmann et al. do not disclose:

- a connector having at least one contact element electro-conductively connected to the coil of the electromagnet, the contact element to be electrically contacted by an assembly-contacting element, upon the connector engaging a connector receptacle;
- the support having a contacting element.

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- a connector having at least one contact element electro-conductively connected to the coil of the electromagnet and in electrical contact with the contacting element.
- the connector having an opening formed therein, and the contact element has a region configured as a service contact which is led through the opening in the connector and the service contact, at least during the assembly of the actuator onto the support, can be electrically contacted by the assembly contacting element.

Voros discloses a connector (24) having at least one contact element (29) electro-conductively connected to the coil (8) of the electromagnet. Voros discloses that the support (2) having a contacting element (29). Also discloses connectors (27, 28, 38, 39) having at least one contact element (29) electro-conductively connected to the coil (8) of the electromagnet and in electrical contact with the contacting element (29). Voros discloses that the connector (24) has an opening (where the screw is located) formed therein, and the contact element (29) has a region configured as a service contact (23) that is led through the opening (where the screw is located) in the connector (24) and the service contact (23) can be electrically contacted by the assembly-contacting element (i.e. a screwdriver not shown).

The invention of Voros has the purpose of providing a pair of normally open electrical contacts so assembled that they may be simply plugged into a socket and extracted therefrom when replacement is necessary.

It would have been obvious at the time the invention was made to modify the actuator of Ballmann et al. and provide it with the connection configuration for the purpose of providing a pair of normally open electrical contacts so assembled that they may be simply plugged into a socket and extracted therefrom when replacement is necessary.

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Referring to claims 1 and 5, no patentable weight has been given to the method of manufacturing limitations (i.e. "causing the contact element to be electrically contacted by an assembly contacting element, even upon said connector engaging a connector receptacle emphasis added) since even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Allowable Subject Matter

3. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. Applicant's arguments filed November 12, 2003 have been fully considered but they are not persuasive.

5. In response to applicant's argument that the opening in Voros is used to secure the screw or service contact, in contrast to the invention, that the opening is used to contact the connector. It is the Examiner's position that, even though the motivations are different, Voros discloses the limitation as claimed because the limitation only requires an opening.

6. In response to Applicant's remark that Ballmann does not disclose a connector having at least one contact element electro-conductively connected to the coil of the electromagnet and

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configured to cause the contact element to be electrically contacted by an assembly-contacting element and also to be engaged with a connector receptacle. It must be noted that Voros discloses the connector 24, contact element 29 connected to the coil 8 (Figure 1).

7. In response to Applicant's remark that there is no disclosure of a contact element that is electrically contactable by an assembly-contacting element, it must be noted that Voros discloses a contact element (screw 29) that is electrically contactable by an assembly-contacting element (a screwdriver or other tool used to tighten the screw 23 shown in figures 1-3), as claimed.

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Voros teaches that providing a connection arrangement to an actuator like the one disclosed by both Ballmann and Voros will provide a pair of normally open electrical contacts so

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assembled that they may be simply plugged into a socket and extracted therefrom when replacement is necessary (column 1 , lines 9-13 of Voros).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaydi A. Aguirrechea whose telephone number is 571-272-2018. The examiner can normally be reached on M-Th 9-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Burton S. Mullins can be reached on 571-272-2029. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


JAA

2/5/04


BURTON S. MULLINS
PRIMARY EXAMINER